SUMMARY

Reconsideration of the application is respectfully requested.

Claims 1-12 were rejected in the above-identified Office Action. Claims 5 and 11 have been amended. Claims 1-12 remain pending in the application.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

To establish obviousness under 35 U.S.C. § 103, the Examiner must view the invention as a whole. Further, the Examiner is to perform the obviousness analysis in accordance with the standard set forth by the Supreme Court in *Graham v. John Deere Co.* That standard requires that the Examiner (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) resolve the level of ordinary skill in the art; and (4) evaluate evidence of secondary considerations. 383 U.S. 1, 17-18 (1966); *see also* MPEP 2141. Secondary considerations include whether the invention met with commercial s uccess, whether the invention answered a long felt need, and whether others attempting the invention have failed. *Graham*, 383 U.S. at 17-18. Further, in applying the *Graham* framework, the Examiner must consider the invention as a whole, without the benefit of hindsight. MPEP 2141.

In "Claim Rejections – 35 USC § 103," item 2 on page 2 of the above-identified final Office Action, claims 1-12 have been rejected as being unpatentable over U.S. Patent No. 6,608,637 to *Beaton et al.* (hereinafter, "Beaton") in view of U.S. Patent Publication No. 2004/0142720 to *Smethers* (hereinafter, "Smethers") under 35 U.S.C. § 103 (a).

Claims 1-4 and 8-10

Claim 1 recites a "mobile communication device comprising:

a plurality of functions to support a plurality of activities to be performed using the

mobile communication device, the activities including at least a call activity;

a navigation button; and

a menu driver to facilitate a user to navigate directly from one activity to another, in

response to user inputs provided through the navigation button, including

saving a first state of a first activity from which the user is navigating from, to enable subsequent re-entry into the first activity at the first state, and <u>entering a second state of a second activity to which the user is navigating to, the second state being the state in which the user last left the second activity</u>."

Thus, when viewed as a whole as is required by law, claim 1 teaches a novel mobile communication device adapted to navigate directly from a first state of a first activity to a second state of a second activity, "the second state being the state in which the user last left the second activity." By providing means to navigate directly between the most recent states of activities, the invention as claimed in claim 1 provides mobile communication device users with a more efficient manner of navigation, removing the need to navigate up to a top menu and then back to to a sub-menu having the target state.

In contrast, the combination of Beaton and Smethers fails to teach or suggest at least "entering a second state of a second activity to which the user is navigating to, the second state being the state in which the user last left the second activity." As acknowledged by the Examiner on page 3 of the final Office Action, Beaton does not specifically disclose this limitation. Additional reasons showing why Beaton does not teach or suggest the limitation may be found in the Remarks section of Applicants' previous Response, dated March 21, 2006. On the same page of the final Office Action, however, the Examiner states that Smethers remedies the deficiencies of Beaton and discloses "entering a second state of a second activity to which the user is navigating to, the second state being the state in which the user last left the second activity." Applicants respectfully disagree.

Even assuming for the sake of argument that Beaton teaches or suggests all the remaining limitations of claim 1, as is argued by the Examiner (Applicants do not concede this point), Smethers simply does not teach or suggest "entering a second state of a second activity to which the user is navigating to, the second state being the state in which the user last left the second activity." Rather, Smethers simply teaches a graphic user interface (GUI) for a mobile device having few input keys, facilitating assignement of the input keys to graphical controls rendered by the GUI, wherein the same key may be assigned to different graphical controls at different times depending upon the context of the display (i.e., whether

the user is making an appointment, checking a stock, etc. See Smethers Figures 8A-8H and 13A-13U). In navigating between activities, "a user traverses from a Home Page . . . into an application . . . and then use[s] the Browser Menu to return to Home" (Smethers, paragraph 62; see also Figures 5A-5F). In browsing from a first state of a first activity to a second state of a second activity (for example, browsing from a text entry state of a appointment-making activity to statistic viewing state for a paticular stock), Smethers simply does not disclose returning to the the state the second activity was last left in, as is required by claim 1. Rather, as is shown by Figures 5B-5C, each time an activity, such as email, is entered, the same first of the graphic controls is highlighted.

The Examiner asserts that Figures 8E-8H show "the transition between one activity ... to the other ... and coming back to the previous activity. Applicants disagree. Only one activity – a calendar application – is illustrated by those Figures, along with a mode menu of the application presenting the user with a number of use modes of the application, such as a text entry ("ABC") mode and a numeric entry ("123") mode. The Figures simply show the user selecting the menu (8E), the menu being displayed (8F), a second mode being selected (8G), and a return to the main display with the new mode selected (8H). Thus, no second activity is even entered, much less entered in the state it was last left.

Further, Smethers does not suggest directly browsing between the most recent states of its activities, as is claimed in claim 1, as Smethers is simply directed to providing a GUI allowing the assignment of a large number of graphic controls to a small number of input keys. One skilled in the art would not find any suggestion in Smethers to modify the mobile device of Smethers to navigate directly between the most recent states of multiple activities, as such a method of navigation does not inherently contribute to or deter from Smethers' stated purpose of providing a GUI allowing a minimum number of keys through context-dependent assignments of graphical controls to the keys.

Accordingly, claim 1 is patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a).

Claim 8 recites limitations similar to those of claim 1, and accordingly is patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a) for at least the same reasons.

Claims 2-4 and 9-10 depend from claims 1 and 8, incorporating their limitations, respectively. Accordingly, for at least the same reasons, claims 2-4 and 9-10 are patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a).

Claims 5-7 and 11-12

Claims 5 and 11 have been amended to overcome the Examiner's rejections. Amended claim 5 recites a "mobile communication device comprising:

a plurality of functions to support a plurality of activities to be performed using the mobile communication device, the activities including at least a call activity;

a navigation button; and

a menu driver to facilitate a user to navigate among selectable sub-activities of an expandable sub-activity of one activity, including presenting the selectable sub-activities as a scrollable list nested in a presentation of the activity, the scrollable list replacing the expandable sub-activity and displaying only a one of the selectable sub-activities at a time."

Thus, when viewed as a whole as is required by law, amended claim 5 teaches a novel mobile communication device comprising a menu driver adapted to replace the display of an expandable sub-activity of an activity with the display of a scrollable list of selectable sub-activities of the expandable sub-activity, showing only one item of the scrollable list at a time. The menu driver saves the user from having to navigate "down a level" to view the selectable sub-activities of the expandable sub-activity, while at the same time requiring no more of the total display surface to display the scrollable list than the expandable sub-activity the scrollable list is to replace.

In contrast, Beaton and Smethers fail to teach or suggest "a menu driver to facilitate a user to navigate among selectable sub-activities of an expandable sub-activity of one activity, including presenting the selectable sub-activities as a scrollable list nested in a presentation of the activity, the scrollable list replacing the expandable sub-activity and displaying only a one of the selectable sub-activities at a time."

At best, Beaton and Smethers disclose a mobile device having a plurality of activities, a navigation button, and a menu driver capable of displaying a scrollable list of application modes (see the above-described text and numeric modes of Smethers) in a nested presentation of the application (See, e.g., Figures 8F-8G of Smethers). The scrollable list shown by Smethers, however, does not include selectable sub-activities of an expandable sub-activity of an activity, and consequently does not replace the expandable sub-activity. Additionally, the scrollable list of Smethers does not show only one item at a time, as is required by claim 1. Further, as argued in Applicants' March 21, 2006 Response, Beaton simply does not teach a scrollable list list in a presentation of an activity.

Additionally, Beaton and Smethers simply do not suggest a menu driver adapted to display sub-activities "down a level," replacing the expandable sub-activity they are associated with while occupying only the same portion of the display as the expandable sub-activity. Beaton is directed to providing a GUI that faciliates multitasking and Smethers is only concerned with providing a GUI that faciliates context dependent assignment of a large number of graphical controls to a small number of input keys. The unique display and navigation arrangement claimed by amended claim 5 does not further either of these purposes, and thus one skilled in the art would find no suggestion in either reference to modify the reference to produce the menu driver claimed in amended claim 5.

Accordingly, amended claim 5 is patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a).

Amended claim 11 is directed toward a method of amended claim 5, reciting similar limitations. Thus, for at least the same reasons, amended claim 11 is patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a).

Claims 6-7 and 12 depend from amended claims 5 and 11, incorporating their limitations respectively. Thus, for at least the same reasons, claims 6-7 and 12 are patentable over Beaton and Smethers, alone or in combination, under 35 U.S.C. §103(a).

CONCLUSION

In view of the foregoing, Applicants submit that claims 1-12 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with this paper, the Commissioner is authorized to charge Deposit Account 500393.

Respectfully submitted,
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